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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,922	04/21/2004	Bernhard Riepler	RIEPLER-4	5644
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COLLARD & ROE, P.C. 1077 Northern Boulevard Roslyn, NY 11576				
EXAMINER BOTTORFF, CHRISTOPHER				
ART UNIT		PAPER NUMBER		
3618				

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,922

Applicant(s)

RIEPLER, BERNHARD

Examiner

Christopher Bottorff

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-14,19-26,32,33 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,6-14,19-26,32,33,37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed July 17, 2006 has been entered. Claims 5, 15-18, 27-31, 34-36, 40, and 41 are canceled. Claims 1-4, 6-14, 19-26, 32-33, and 37-39 are pending. Claims 2-4, 6-14, 19-26, 32-33, 37, and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species. Claims 1 and 39 have been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "an insert piece disposed between a binding mounting region and a top of the ski" on lines 12-13. However, the binding mounting region is disclosed as forming a portion of the top of the ski. That is, the binding mounting region and the top of the ski coincide. As a result, the claim is not clear as to how an object may be disposed between the binding mounting region and the top of the ski. For the purposes of examination, this limitation has been interpreted as requiring that the insert piece be disposed in the top of the ski since a more specific location is not disclosed in relation to the elected species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Golling US 5,954,357.

Golling discloses a ski 63 comprising a top layer having a top surface 63a and a running layer having a running surface 63b lying opposite the top surface 63a. See Figures 17 and 18. The longitudinal sides of ski 63 form edging elements extending in the longitudinal direction of the ski. See Figure 17. The top surface 63a of the top layer has at least one recess 65, which is provided with a device 67 capable of increasing slipping and friction resistance at the top surface. See Figures 18-23; column 5, lines 41-44; and column 6, lines 3-36. The device 67 comprises an insert piece disposed in a top of the ski. See Figures 18-23. The insert piece has a gripping surface, which has a surface roughness that is more pronounced than the surface of the top layer. See Figure 19 and column 6, lines 12-22.

In regard to claim 39, the recess 65 is a groove in the top layer, and the insert piece 67 is affixed to the groove 65 surfaces at a surface region by means of an adhesive bond. See Figure 17 and column 4, lines 16-20.

Response to Arguments

Applicant's arguments filed July 17, 2006 have been fully considered but they are not persuasive.

In the first paragraph, Applicant asserts that claim 1 recites that the insert is "disposed between the binding mounting region 31 and a tip of the ski (see Fig. 1)." However, claim 1 actually recites the "top" of the ski, not the "tip" of the ski. Moreover, the species related to Figure 1 was not elected, and the locations disclosed with the species related to Figure 1 are not generic. In addition to the binding mounting region and the tip of the ski, the species related to figure 1 also includes an insert located at the binding mounting region. Neither of these locations, nor any of the other locations disclosed in relation to the other nonelected species, was disclosed in relation to the elected species. Thus, Applicant's assertions with regard to claim 1 are not correct or accurate.

Applicant's arguments with respect to Stewart have been considered but are moot in view of the new grounds of rejection.

Also, the arguments directed to the feature of picking up and carrying the ski relate to the intended use of the device rather than the physical structure of the device. However, it is well settled that claims containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all of the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Here, Golling discloses all of the structural limitations of the claims, so the

intention to use the structure to pick up and carry the ski is not relevant to the patentability of the apparatus.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Berta US 3,437,345 discloses a ski with an insert.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher Bottorff